

FEB 24 2004

OFFICIAL

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF : Albert James Yovichin, Daniel Ray Downing,
and James Alfred Benzing, II

FOR : **HOT FORMING SYSTEM TO PRODUCE
PRE-CURED INNERLINERS**

SERIAL NO. : 09/831,393

FILED : August 20, 2001

LAST OFFICE ACTION : August 13, 2003

EXAMINER : Geoffrey L. Knable

GROUP ART UNIT : 1733

ATTORNEY DOCKET NO. : DN1998168US (30163.30197)

Akron, Ohio 44308-1471
February 24, 2004

CERTIFICATE OF MAILING

I hereby certify that this **DECLARATION OF HEATHER M. BARNES** is being
transmitted by facsimile on the date shown below to the United States Patent and Trademark Office
at (703) 872-9306.

2/24/04
Date

Connie J. Nutter
Connie J. Nutter

DECLARATION OF HEATHER M. BARNES

Commissioner for Patents
Mail Stop Petition
P.O. Box 1450
Alexandria, VA 22313-1450

Page 2 of 4

Dear Sir:

I, Heather M. Barnes, declare as follows:

1. My name is Heather M. Barnes.
2. I am an attorney at Brouse McDowell.
3. I have been employed with Brouse McDowell since November 11, 2000.
4. My four and one-half (4 ½) years of practicing also includes a year of experience at the law firm of McLaughlin and McNally in Youngstown, Ohio.
5. With respect to the patent application for a HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS having serial number 09/831,393, I am the responsible attorney. Our attorney docket number is 30163.30197 for this case.
6. As the responsible attorney, I am in charge of prosecution before the U.S. Patent and Trademark Office for this case, including monitoring of its docket.
7. Roger D. Emerson is the originating, client manager, and client contact for the applicant, including this specific case.
8. Docketing procedures at Brouse McDowell for the intellectual property group involve the following steps to ensure proper procedure:
 - The docketing clerk, James E. Elder, receives incoming docket;
 - Mr. Elder docket the communication from the U.S. Patent and Trademark Office or foreign counsel, etc.;
 - The newly docketed communication, file, and docket sheet with the predetermined docket dates are given to the responsible attorney, who is also known as the matter manager;
 - The responsible attorney reviews the communication and the newly entered docket dates to ensure that the dates are correct;
 - If the dates are correct, the responsible attorney initials the entries;
 - If the docket entries are incorrect, the responsible attorney changes these dates to the correct date; and
 - Mr. Elder reenters the correct dates and represents the case to the responsible attorney for confirmation. This process is repeated until the responsible attorney initials the entries on the docket sheet.
9. In following these procedures, I have only missed one docketing deadline in over four and one-half (4 ½) years of practice.

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10. In this case, since the applicant is The Goodyear Tire & Rubber Company (Goodyear), the U.S. Patent & Trademark Office sends its communications directly to Goodyear. Goodyear forwards the communications to Brouse McDowell.
11. In this case, the final office action was mailed on August 13, 2003.
12. Amendment B was filed on November 11, 2003 responsive thereto. See docket sheet, attached hereto as Exhibit A.
13. Goodyear received an advisory action on December 18, 2003.
14. Subsequently, the advisory action was sent to Brouse McDowell. See Exhibit B.
15. I remember reviewing the advisory action and informing another attorney who was working on the case that it came.
16. I sent the advisory action to Mr. Elder for docketing.
17. On February 23, 2004, Mr. Elder brought me this case along with the docket sheet stating that due to problems with the docketing software, the advisory action did not appear on my docket until February 23, 2004. See Exhibit C. Apparently, it was supposed to appear on my docket on February 16, 2004, see Exhibit D (docket report under new software procedure to check docket dates are not missed showing due date of February 16, 2004), but it did not. See Exhibit E (docket sheet from February 16, 2004, using old procedure, showing all items with due dates of February 16, 2004).
18. Upon inspection of the file, it came to my attention that the advisory action was incorrectly docketed.
19. Further, records indicate that I never saw the docketed due dates from the advisory action due to numerous activities occurring at that time, including a critical computer crash at Brouse McDowell and a file transfer of over two thousand (2,000) matters.
20. Because I never reviewed the initial docket entries for the advisory action, I had no way of tracking the case.
21. The abandonment of this application was unavoidable since I had never been given the opportunity to ensure that docketing dates were correct.

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22. It is unlikely that the above-recited events and error will be made in the future. In addition, James E. Elder and I have thoroughly discussed this event and made certain resolutions to avoid such reoccurrences.
23. I further declare that the statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 in the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Respectfully submitted,

BROUSE MCDOWELL

February 24, 2004
Date

Telephone No.: (330) 535-5711
Fax No.: (330) 253-8601

#565521 v1

Heather M. Barnes
Heather M. Barnes, Esq.
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500 First National Tower
Akron, Ohio 44308-1471

EXHIBIT A

Emerson and Skerio**Case History for: 30163:30197**

National Phase US Patent Appl. - HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS

Orig. RDE C.M. RDE C.C. RDE Resp. HMB

Due Date	Action Required	Action Date	Action Taken	Drop Dead Date
8/15/01	Response due to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)	8/15/01	Per DMJ move 7-20 Per DMJ move 7-25 Per DMJ move 7-30 Per DMJ mo	8/15/01
9/18/01	Rec'd Notification of acceptance of application under 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495	9/18/01		9/18/01
10/11/01	Rec'd Filing Receipt	10/11/01		10/11/01
12/31/01	IDS due - have we rec'd filing receipt-if yes IDS due 2 months after receipt of filing receipt	10/1/01	Per DMJ move 11-30 Per DMJ move 12-26 Per DMJ move 12-31 Filed ID	12/15/01
1/3/02	Have we filed the assignment yet?	10/1/02	Rec'd Notice of Recordation of Assignment Per DMJ move 11-30 Per DMJ	12/15/01
5/20/02	Foreign Filing due Rec'd Filing Receipt	5/20/02	Filed Already per JMS;	8/20/02
5/20/03	Response due to Office Action	5/20/03		6/19/03
11/11/03	Response due to Final Rejection	11/11/03		11/13/03
12/11/03	Notice of Appeal due to Final Rejection	11/11/03	Filed amendment B	11/13/03
12/22/03	Rec'd advisory action (Mail date 12/16/03), this item was redocketed due to system malfunction	12/22/03		12/22/03
2/24/04	Response due to advisory action, this item was redocketed due to system malfunction			3/16/04
2/24/04	Notice of appeal due to advisory action, this item was redocketed due to system malfunction		Move 1 day from 2/23/04 - 2/24/04 plumb	3/16/04
2/24/04	Request for continued examination, this item was redocketed due to system malfunction			3/16/04

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,393	08/20/2001	Albert James Yovichin	DN1998168US	2980

7590

12/16/2003

Roger D Emerson
The Goodyear Tire & Rubber Company
1144 East Market Street
Patent Department D 823
Akron, OH 44316-0001

EXAMINER

KNABLE, GEOFFREY L.

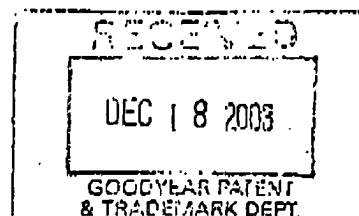
ART UNIT

PAPER NUMBER

1733

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



Advisory Action

Application No. ...

09/831,393

Applicant(s)

YOVICHIN ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

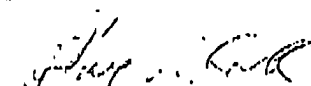
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1, 3-5 and 10

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Geoffrey L. Knable
Primary Examiner
Art Unit: 1733

Continuation Sheet (PTOL-303)
009/831,393

Application No.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the 35 USC 112, first paragraph rejection of claim 10 and the prior art rejection over Böhm (US 4,089,360) alone.

Continuation of 5. does NOT place the application in condition for allowance because: principally the reasons of record. It is first again argued that Seiberling '883 does not teach a profiled precured inner liner. This is not disputed. However, it is again noted that the primary references clearly suggest precuring the inner liner before assembly with the tire, the secondary references providing a very strong motivation to profile the liner so that it is thicker at the central areas. In other words, the secondary references evidence that the problem that when a flat built tire is shaped to toroidal form, a uniform liner must of necessity become thinner towards the crown because of the simple fact that the diameter/circumference of the material is increasing with toroidal shaping, is known. Further, these references also clearly identify a known solution to this problem (other than the simply thickening the entire liner) - namely to make the liner thicker in the central regions to counteract the thinning with shaping. To form a liner in such contoured form would therefore have been obvious for the clearly expected advantage of avoiding the thinning of the liner, this also enabling the use of less overall material since a thicker than necessary overall thickness layer need not be used. As to the arguments with respect to the curing press and plate configuration, note again that the primary references suggest precuring the inner liner (to enable bladderless cure), these curing methods including "usual methods of curing" in Seiberling (note esp. col. 4, lines 16-31) and including a conventional sulfur cure in GB '031. The artisan would thus clearly have been taught or motivated to adopt well known and conventional means to cure rubber sheets, it being again submitted to be extremely well known per se in this art to use a curing press (i.e. with two adjacent press platens, etc.) to cure rubber sheets, use of such extremely well known and conventional means being obvious absent some convincing argument to the contrary. As to the platen configuration, insofar as it is considered to have been obvious to utilize a profiled liner, it is submitted that it would have been readily apparent to the artisan that the platens should be appropriately shaped to the desired shape of the liner. In other words, if one is trying to mold/cure a certain shape material, they typically would be expected to use a cure press with platens that are of the desired shape. This represents an entirely expected and entirely obvious step for the ordinary artisan and applicant has not convincingly shown to the contrary. It is also argued that Seiberling '883 does not teach or suggest providing the cured portions to be of a length equal or greater than the drum circumference. This argument is unconvincing as clearly Seiberling '883 as well GB '031 desire complete cured internal layer which would have clearly required that the liner be cured over at least the circumferential length of the drum - the alternative, i.e. leaving some part of the liner uncured clearly is inconsistent with the teachings of the references. It is also argued that Mirtain is directed to an uncured liner for use with a bladder cure. This is also not disputed. However, this reference provides clear evidence of an understanding by the artisan of a known problem in tire building - namely the fact that when a flat built tire is shaped to toroidal form, a uniform liner must of necessity become thinner towards the crown because of the simple fact that the diameter/circumference of the material is increasing with toroidal shaping (e.g. note col. 1, lines 21-27 and 40-48 of Mirtain). While it is agreed that this reference was not concerned with trying to provide a bladderless cure and thus only describes the more conventional uncured liner, it is again submitted that the ordinary artisan would have appreciated that the problem of thinning of the liner would be present regardless of whether the liner is uncured or precured and applicant has provided no convincing line of reasoning to show otherwise. In other words, the simple geometric realities of an increasing circumference when shaping from flat to toroidal form are present regardless of the cure state of the inner liner and it is considered that the artisan would have expected the solution taught by the reference (selective thickening) to also suitably provide the desired results regardless of the cure state of the liner. The Böhm reference further supports this finding insofar as it provides a liner that is in important part precured as well as contoured to avoid these same thinning problems (e.g. col. 3, lines 18+; col. 8, lines 32+). To form a liner in such contoured form would therefore have been obvious for the clearly expected advantage of avoiding the thinning of the liner, this also enabling the use of less overall material since a thicker than necessary overall thickness layer need not be used. It is also urged that Mirtain '338 teaches away from preserving the profile as it smoothes out the profile with curing. The curing referenced in Mirtain is however in reference to the final curing of the tire, not precuring of the liner. Further, this reference still clearly evidences an understanding in this art of the geometrical realities facing the artisan during the final shaping/cure of a tire and provides a solution, namely selective thickening of the liner at the central region to avoid the inevitable thinning. Although this reference also patterns the liner for air evacuation against the bladder, which pattern apparently becomes smoothed out in the final cure, this does not take away from the teachings with regard to the overall profile desired of a liner. In other words, it is considered that the artisan would have understood that the patterning teachings would be unnecessary if curing is effected without a bladder (as taught/enabled by the primary references). This however is not considered to take away from or be inconsistent with the teachings with respect to the liner contour.

EXHIBIT C

Emerson and Skeriotis**Criteria: HMB (2/23/2004 - 2/23/2004)**

Due Date Client No. Job Description

Orig C.M. C.C. Resp Drop Dead

Action Required**Action Taken**

2/23/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDB RDB RDB RDB HMB	3/16/2004
Request for continued examination, this item was redocketed due to system malfunction				
2/23/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDB RDB RDB RDB HMB	3/16/2004
Response due to advisory action, this item was redocketed due to system malfunction				
2/23/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDB RDB RDB RDB HMB	3/16/2004
Notice of appeal due to advisory action, this item was redocketed due to system malfunction				

EXHIBIT D

Emerson and Skeriotis**Criteria:** (2/16/2004 - 2/16/2004)

Due Date Client No. Job Description

Action Date Orig C.M. C.C. Resp Drop Dead

Action Required**Action Taken**

2/16/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDE	RDE	RDE	HMB	3/16/2004
Request for continued examination, this item was redocketed due to system malfunction							

2/16/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDE	RDE	RDE	HMB	3/16/2004
Notice of appeal due to advisory action, this item was redocketed due to system malfunction							

2/16/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDE	RDE	RDE	HMB	3/16/2004
Response due to advisory action, this item was redocketed due to system malfunction							

2/16/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDE	RDE	RDE	HMB	3/16/2004
[REDACTED]							

2/16/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDE	RDE	RDE	HMB	3/16/2004
[REDACTED]							

2/16/2004	30163:30197	National Phase US Patent Appln.: HOT FORMING SYSTEM TO PRODUCE PRE-CURED INNERLINERS	RDE	RDE	RDE	HMB	3/16/2004
[REDACTED]							

EXHIBIT E

Emerson and Skeriotis

Criteria: HMB (2/16/2004 - 2/16/2004)

 Due Date | **Client No.** | **Job Description** |[illegible]

Action Required

Action Taken

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Emerson and Skeriotis**Criteria: HMB (2/16/2004 - 2/16/2004)**

Due Date Client No. Job Description

Action Required

Action Taken

Orig C.M. C.C. Resp Drop Dead

2/16/2004	31180-23940	[REDACTED]	[REDACTED]	HMB
2/16/2004	31180-23940	[REDACTED]	[REDACTED]	HMB
2/16/2004	31304-22619	[REDACTED]	[REDACTED]	HMB
2/16/2004	31420-24405	[REDACTED]	[REDACTED]	HMB